

REMARKS

In an Office Action dated May 6, 2003 the Examiner mailed a "final rejection," rejecting claims 1-36 over a reference Ruat (WO 95/20200).

The undersigned appealed to the Board of Patent Appeals and Interferences, filing an Appeal Brief on September 29, 2003.

Rather than filing an Examiner's Answer, in an Office Action dated January 12, 2004, the Examiner allowed claims 1-32 and stated that claims 33-36 were still rejected.

In reliance upon the Examiner's Office action, on March 1, 2004 the undersigned canceled claims 33-36. The Examiner telephoned the undersigned on March 11 and March 18, 2004 and interviews took place in which the undersigned agreed to small changes in independent claims 1, 10, 20 and 30, in each case reciting that the "second information" was derived by means of electronic computation from the first information. The undersigned agreed to these changes in reliance upon the Examiner's agreeing that the claims, with these amendments, would be allowed. A Notice of Allowance should have followed, and indeed on March 20, 2004 the Examiner gave a Notice of Allowability to the application.

PAIR shows an Examiner Interview Summary Record (form PTOL-413) dated March 19, 2004, but this Examiner Interview Summary Record has never been provided to the undersigned. It is requested that this Examiner Interview Summary Record be immediately provided to the undersigned.

Now, some five months later, the Examiner has mailed an Office Action again rejecting claims 1-32 over the same reference Ruat. The Examiner rejects claims 1-4, 7, 9-13, 16, 18-23, 26 and 28-31 as supposedly anticipated by Ruat. The remaining claims are rejected as supposedly

obvious over a two-way combination of Ruat and a second reference.

It is understood that this reversal (on January 12, 2004 claims 1-33 are allowed over Ruat, and eight months later they are rejected over Ruat) is due to the "second pair of eyes" review due to the application being in US class 705.

Due to the absence of the Examiner Interview Summary Record of March 19, 2004, the present record fails to make clear that the claims that now stand rejected include the amendments which the Examiner suggested, and to which the undersigned agreed, on March 11 and 18, 2004. For that reason the present Amendment lists these changes as "present" amendments even though the amendments were made in March of 2004.

The Examiner is reminded of the arguments which have previously been made by the undersigned regarding Ruat.

Each independent claim 1, 10, 20, specifically limits itself to a "purchaser" who "purchases" at postal indicium. The Examiner expresses the view that Ruat sets forth this limitation. This view is in error. The undersigned has diligently studied the English translation of Ruat which for the first time has been provided by the Examiner in this September 9, 2004 Office Action. Nowhere in Ruat is the undersigned able to find even a mention of the word "purchaser" nor any synonym therefor.

In putting forth supposed support for the new rejection, the Examiner notes that Ruat does mention the word (assuming the translation is not in error) "sender".

Importantly, the rejection can only work if somehow the distinct terms "sender" and "purchaser" mean exactly the same thing. In an effort to force these two words to mean the same thing, the Examiner states that "inherently, the purchaser of the franking device must submit the information about his/her identity to the postal service so as to rent, lease, or buy the device,"

citing to page 6, lines 10-16 of the Ruat translation.

The undersigned has closely studied the cited page and lines of Ruat and is quite unable to find any support for this claim that "the purchaser of the franking device must submit the information about his/her identity to the postal service so as to rent, lease, or buy the device." The Examiner is requested to point out exactly where Ruat supports this claim or to withdraw the rejection.

It is noted that the Examiner's claim regarding "submitting the information about his/her identity" does not track the claim language in any event. The claims 1, 10, 20 each are limited to "information **indicative of**" the purchaser's identity (emphasis added). These are not the same thing.

In any event the Examiner's claim is false, for at least two distinct reasons.

First, it is simply false to say that one must submit information indicative of one's identity to the Postal Service to obtain a postage meter (franking device). (More relevant is whether at the time this application was filed, it was required that one do so.) The undersigned personally obtained a postage meter in the United States from the Postal Service without ever submitting any information indicative of the undersigned's identity. The undersigned was never asked for a driver's license, a passport, or any other form of identification. This postage meter is used by the undersigned's patent law firm to this day. Thus the Examiner is simply wrong to say that "inherently" one must submit information about one's identity to obtain a postage meter. Motivated by the case of *In Re Ahlert and Kruger*, 165 USPQ 418 (CCPA 1970) applicant's attorney hereby challenges the Examiner's claim and asks whether the Examiner can show support for this claim, namely that supposedly as of the filing date of this application it was somehow required to provide such information as a precondition to obtaining a postage meter.

There is a second and perhaps more fundamental error in the Examiner's view. Even if it were true that one must submit information indicative of one's identity to obtain a postage meter

(which it is not), this would not mean that automatically the “purchaser” of an indicium somehow “inherently” must provide information indicative of identity as a precondition of purchase. (Or, more relevantly, whether this was the case at the time this application was filed.) Indeed the undersigned has personally purchased postal indicia at post offices without having to provide information indicative of the undersigned’s identity.

In the case of a postage meter that is at the sales counter of a post office, it is not clear who is the “purchaser” of the postage meter, but it is clear that the purchaser of postal indicia is not the “purchaser” of the postage meter itself. Perhaps the Postal Service is the purchaser of the postage meter. Perhaps the Postal Service is required (as the Examiner suggests) to give proof of identity to the Postal Service (as the Examiner urges) although the undersigned is skeptical of this. But in no way is the purchaser of the postal indicia somehow required to provide proof of identity as a precondition of purchasing the postal indicia.

When the Examiner attempts to treat “purchaser” and “sender” as supposedly synonymous (which the two terms would have to be if the Examiner’s rejection were free from error) this goes against the plain language of the specification and the claims. Claims 1-29 all refer to a “purchaser” while claims 30-32 all refer to a “sender”. If the two terms meant the same thing, then a single term would have been used in the claims. The claims use the terms as having non-identical meanings, and this means the Examiner simply cannot treat the terms as synonyms.

In any event the two terms cannot mean the same thing. The Examiner has not pointed to any dictionary that says the terms are synonymous, nor can the Examiner do so as they simply do not mean the same thing.

Ruat does not, in any event, appear to find in the indicium information indicative even of the sender (let alone information indicative of the purchaser of the indicium, which is quite a different matter). At translation page 13, lines 4-6, Ruat merely teaches that the indicium may “allow at least partial identification of the sender” and “this partial identification of the sender” is

what allows access to an encryption key. The Examiner is invited to show where in Ruat there is actual identification of the sender (as distinguished from the **partial** identification set forth in the quoted language) or to withdraw the rejection for this reason.

The preceding points suggest that the rejections of independent claims 1, 10, and 20 are in error and reconsideration is requested for these reasons.

Turning with specificity to claim 1, there is a further limitation that second information which is "derived from" the information indicative of identity of the purchaser be "printed upon" the postal indicium. The Examiner, in an attempt to find this in Ruat, states that this is found somehow in "figs. 1-2". But those two figures teach away from any such printing. Instead, so far as the undersigned is able to discern, these figures (and the accompanying text at translation page 8, lines 14-15) teach specifically that what is printed is the "name and address of the **recipient**" and not the sender or purchaser. It is speculated that the Examiner is under the mistaken impression that the name and address in block 20 is somehow the name and address of the purchaser. But this is not, apparently, the case. The Examiner is invited to show where, in Figs, 1-2, this printing on the indicium of information indicative of the identity of the purchaser may be found. If the Examiner is unable to do this, it is requested that the rejection be withdrawn for this reason.

Yet another limitation of claim 1 is quite unmet in Ruat. Claim 1 is limited in that the provision of information indicative of identity of the purchaser (not the sender) is a **precondition** of purchase. In contrast, Ruat teaches that payment happens only at some later time, apparently long after the postal indicium is printed that supposedly contains the information indicative of identity. See translation page 13, lines 18-20. This apparent failure to anticipate, and apparent teaching away, suggest not only that Ruat fails to anticipate the claim but indeed cannot render it obvious.

Claim 10 is limited in that the provision of the purchaser identity information must be a

"precondition" of "receiving" the mail piece "into the mail." Ruat, in contrast, teaches that there is no such precondition. Instead, as set forth at translation page 12, lines 19-20, Ruat teaches that the mail piece is "sent by depositing it in a mail box or in a post office". Only later, long after the mail piece has been deposited with the post office, is there any suggestion that some negative action might be taken, for example at translation page 13, lines 16-17. This sequence is plainly shown in translation Fig. 7. Thus not only does Ruat not anticipate, but Ruat actively teaches away from the claimed limitation. The Examiner is invited to point to the place in Ruat where supposedly this limitation may be found, or to withdraw the rejection.

Independent claim 30 specifically limits itself to a method relating to steps performed by a "recipient" of delivered mail pieces, and the steps are limited in that certain actions are taken with respect to a "list of expected senders" meaning senders that are expected by the recipient.

Ruat makes numerous mentions of "recipients", meaning those who receive mail pieces. The Examiner states that the step of "determining whether the sender whose identity is indicated by the information is on the list of expected senders" is somehow found in Ruat at translation, page 10, last paragraph. The undersigned has diligently studied the last paragraph at translation page 10 and is quite unable to find such a list of senders expected by the recipient. The Examiner is requested to point out by page and line where this list can be found, or to withdraw the rejection.

The undersigned has diligently studied the last paragraph at translation page 10 and is likewise quite unable to find any hint or suggestion of determining whether the identity of the sender is on such a list of senders expected by the recipient. The Examiner is requested to point out by page and line where this "determining" can be found, or to withdraw the rejection.

Claim 32 specifically limits itself to **inspecting** a mail piece if the sender thereof is not on the **recipient's list of expected senders**. The Examiner states that this limitation can somehow be found in Windel col. 46 or at col. 7, lines 32-46. But Windel says nothing about checking a mail piece against a recipient's list. Windel instead teaches away from this, teaching a system in

which the identity of the sender is known only **after the envelope is opened**, as is set forth plainly at the very location cited by the Examiner at Windel col. 7, lines 32-46.

Windel teaches repeatedly that inspections would be undertaken by the Postal Service, apparently to attempt to detect someone having tampered with a postage meter. The claim calls for inspections being undertaken by a recipient, based upon a list of the recipient's expected senders. Windel thus teaches away from the limitation of claim 32.


When the undersigned canceled claims 33-36, this was in reliance upon the Examiner's having supposedly allowed claims 1-32. Now that the Examiner has taken back this allowance, the undersigned wishes that the undersigned had never canceled those claims. They are now reintroduced as new claims 37-40.

New claims 41-43 has been added, which is based upon claims 30-32, and which contain additional claim limitations. Form PTO-2038 is attached to pay for these claims. Any deficiency in claim fees may be charged to our deposit account 15-0610.

As for new claims 37 and 38 (former claims 33 and 34), the Examiner has not pointed to any place in Ruat or Brasington where the two distinct printing processes may be found, and indeed Ruat teaches away from this by teaching that everything is printed at once.

As for new claims 39 and 40 (former claims 35 and 36), the Examiner has not pointed to any place in Ruat or Brasington where the indicia free from certain information may be found, and indeed Ruat teaches away from this by teaching that everything is printed at once.

Respectfully submitted,


Carl Oppedahl
PTO Reg. No. 32,746
Oppedahl & Larson LLP

P O Box 5068
Dillon, CO 80435-5068
telephone 970-468-6600
email oppedahl@patents.com